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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/813,688	03/19/2001	James West	251208-1010	3445

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EXAMINER

NGUYEN, TAN D

ART UNIT PAPER NUMBER

3629

DATE MAILED: 10/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/813,688

**Applicant(s)**WEST ET AL. **Examiner**

Tan Dean D. Nguyen

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Response to Amendment***

The amendment filed 6/10/2004 have been entered.

***Claim Rejections - 35 USC § 103***

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. **Claims 17–19, 25-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over LOVE (US Patent 4,043,449) in view of STEFANY (US 2002/0178626) and Article 4/1981 or HELN et al (US Patent 4,643,301) or BENDER (US Patent 6,435,934).**

**As for claim 17**, LOVE fairly discloses a method for displaying an article of jewelry comprising:

(a) providing a display apparatus in close proximity connection with the article of jewelry, wherein the display has a defined love story theme (anniversary or birthday which inherently include ideas of joy and love),

(b) delivering the article of jewelry in a box (Fig. 1 or 2, element 10),

(c) providing a presentation folder to be associated with the jewelry article containing a personal love note, the presentation folder further including a graphic image (Fig. 2, flower symbol (14)) that is associated with the love story theme,

(e) promoting an association of the article of jewelry with the personal note and the story theme (see col.1, lines 5-50, which teaches the jewelry being associated with the decorative matter of the card to provide an integrated visual effect or functionally

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and aesthetically integrated into the message bearing-unit of the card). Note that LOVE discloses the association of the personal message to various theme such as birthday or anniversary which normally involve love, joy, and celebration atmosphere and the use of non-specific novelty types of greeting for such occasion, therefore the selection of defined love story theme is inherently included in LOVE or would have been obvious in view of the various theme teachings above. As for further message/sign/insignia on the folder or box to improve the quantity of influence, it would have been obvious to do so if desired in view of the view of the teaching of using multiple means such as printing message, indicia, decorative matter/image (flower shape) , etc. as taught by LOVE above.

LOVE teaches the claimed invention except for in (a) love story theme from popular romantic literature, (b), the box containing at least one miniature book printed with a love story that is associated with the love story theme and (d) encouraging a correlation of the jewelry with the defined love story theme and signature jewelry collection thereby emphasizing and enhancing the romantic significance of the ring.

LOVE teaches the use of printed card or folder to describe personal messages with respect to the items. The addition of printed message on a printed sheet or miniature book would have been obvious as mere increasing the volume of messages to increase the effects of affecting the giving jewelry. Note that the general teaching of duplication of parts to double the effects is well known and would have been obvious.

In re Hazra, 124 UQ 378. As for the forms of the printed messages, the use of printed material such as sheet, or brochure or pamphlet or miniature book are interchangeable

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and would have been obvious based on the size and shape and display of the package. As for the association of the messages and other to the main theme, love story, this is fairly taught in LOVE as shown on cols. 1-2 as indicated above and/or would have been obvious to do so to increase the value or integrated visual effect of the earrings or the like.

STEFANY teaches a method for displaying an article of jewelry and the general concept of combination of personal greeting message, ornament and jewelry (necklace) as a system for enhancing value of the jewelry and especially preserve memory, long term remembrance, love and sentimental effect of the sender [0001, 0024, Fig. 5, Fig. 3]. STEFANY fairly teaches the mating of the message and ornament or other items with the jewelry item to reflect the sentiment, feelings and impression of the sender to the receiver, i.e., love or romantic theme: "You are a knock out" and in combination with boxing glove which normally relating to a "knockout", (Fig. 3, element 13) or heart shape/symbol which conveying love or romance (Fig. 3). STEFANY also teaches the attachment of a printed sheet (39) or brochure, printed instructions or explanations of the item attached, packaged together with the card along with the package. It would have been obvious to modify the teaching of LOVE by promoting association of the message and other items in the package with the jewelry item to reflect the sentiment, feelings and impression of the sender to the receiver, i.e., love or romantic theme, if desired as taught by STEFANY above.

ARTICLE 4/81 is cited to teach an example of well known marketing tool of relating a love story theme on a product, i.e. movie, from popular romantic literature, to

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inherently attract customers due to the popularity of the literature (see abstract). It would have been obvious to modify the method of LOVE /STEFANY by associating the love story theme from popular romantic literature as taught by ARTICLE 4/81 as a well known marketing tool to attract customers who are familiar or like the literature.

HELN et al is cited to teach well known practice of including a booklet or similar printed material in a box/container whereby the printed material, usually in booklet form, which compliments the item in the box for various intended purpose (see col. 1, lines 5-10, lines 45-50). In similar teaching, BENDER is cited to teach well known practice of attaching miniature booklet or similar printed material in a jewelry box/container whereby the printed material, usually in booklet form, which compliments the item in the box for various intended purpose (see col. 1, lines 5-40). It would have been obvious to modify the displaying an article of jewelry of LOVE/STEFANY/ARTICLE 4/81 by attaching a miniature booklet to further compliment or increase the level of complementation about the item if desired as taught by HELN et al or BENDER above. As for the limitation of the booklet printed with a love story associated with the theme, this would have been obvious in view of the emphasis of associating of the message to the article as taught by LOVE or LOVE /STEFANY above.

As for dep. claim 18, this is shown on col. 1, lines 7 or Fig. 2, (34). The use of other similar well known type of ring is taught on col. 1, line 8 "or the like".

As for dep. claim 19, the heart symbol is a cherished symbol and has always imbued with the energy of love, mystery, romance, and sexual passion regardless of the century or culture. It would have been obvious to modify the flower insignia of LOVE

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with the heart shape insignia to express a sentiment or energy of love, mystery, romance, and sexual passion regardless of the century or culture.

As for dep. claims 25-26, these are taught in col. 2, lines 5-25. The addition of printed message on a printed sheet or folder would have been obvious as mere increasing the volume of messages to increase the effects of affecting the giving jewelry. Note that the general teaching of duplication of parts (writings or insignias or indicia) to double the effects is well known and would have been obvious.

**3. Claim 20, 19 (2<sup>nd</sup>) are rejected under 35 U.S.C. 103(a) as being unpatentable over LOVE in view of STEFANY and ARTICLE 4/81 or HELN et al or BENDER as applied to claims 17-19, 25-26 above, and further in view of Article 10/2000 ("Jewel in the Crown").**

As for dep. claim 20, Article 10/2000 is cited to teach the step of personalizing article of jewelry by engraving personal or secret message or words on the jewelry (page 3). Article 10/2000 also teaches the use of sentimental phrases to show love such as "my heart is yours" attached to the jewelry articles (page 2). It would have been obvious to modify the displaying method of LOVE alone or in view of STEFANY or HELN et al or BENDER by engraving words on the article of jewelry as taught by Article 10/2000 to enhance the personalizing effect of the jewelry. As for the using of the "love story" words, it would have been obvious to do so if the theme of the article is love in view of the teaching of love by Article 10/2000 "my heart is yours".

As for dep. claim 19, it's well known that the heart symbol is a cherished symbol and has always imbued with the energy of love, mystery, romance, and sexual passion

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regardless of the century or culture. It would have been obvious to replace words "love story" with the heart shape shaped insignia on the jewelry in view of claim 20 above.

**4. Claims 1-9, 21-22, 10-16, 23-24 are rejected (1<sup>st</sup>) under 35 U.S.C. 103(a) as being unpatentable over LOVE / ARTICLE 4/81 in view of MOLFESE (US 2002/0002842) or further in view of STEFANY (US 2002/0178626) or HELN et al (US Patent 4,643,301).**

The teaching of LOVE / ARTICLE 4/81 and other obvious teachings of STEFANY and HELN et al are cited in claim 17 above. As for the promotion of the purchased item, this is inherently included in the general teaching of LOVE and further in view of the teaching on col. 1, lines 10-20, which teaches the proposal of articles of merchandise be mounted on and offered to the public and wherein the folded card and gift be associated with a container and sold as a packaged gift article. **As for claim 1**, LOVE fails to teach (1) providing a 1<sup>st</sup> insignia on an inner diameter of the a shank of the ring, (2) providing a 2<sup>nd</sup> insignia on a portion of the ring that is visible when the ring is positioned on a finger (or difference between claim 17 and claim 1). MOLFESE is cited to teach the enhancing the appearance of a ring or increasing the personalizing of a ring by engraving first ornamental markings or insignia or writings "Amy loves Joe" on a surface part of the ring [0004, 0005, 0017] and engraving a second insignia (heart shape) [0019] on a portion of the ring that is visible when the ring is positioned on a finger (see Fig. 1 or 6). It would have been obvious to modify the displaying a ring of LOVE / ARTICLE 4/81 by carrying out steps (1) and (2) as taught by MOLFESE to enhance the personalizing or appearance of the ring. Note that LOVE teaches the



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displaying of personal adornment such as earrings or the like which would inherently include finger ring or would have been obvious to apply to finger ring (see col. 1, lines 5-10).

The engraving of the 1<sup>st</sup> insignia on other part of the ring, inner diameter of the shank, or the selection of other well known or similar type of finger ring, etc., are considered as routine experimentations for personalizing or enhancing the appearance of a ring and would have been obvious. This is considered as optimizing operating conditions or result effective variables and the optimizing of result effective variables is considered as routine experimentation to determine optimum or economically feasible reaction conditions and would have been obvious to the skilled artisan. In re Aller, 105 USPQ 233.

**As for dep. claim 2**, MOLFESE discloses the inclusion between words ornamental features such as heart shape and other markings so long as these markings do not destroy the effect of the repeating words [0019].

**As for dep. claims 3, 4**, the inclusion of other picture or caption in the display to increase the amount of love theme would have been obvious in view of the teaching of using messages, indicia, image, indicia, on a card or folder or frame, etc. to associate with the article theme. Note that on col. 1, lines 15-20, LOVE mentions the use of a picture as part of the display.

**As for dep. claim 5**, the selection of a love quote would have been obvious in view of col. 2, lines 5-12, which teaches the selection of a selective message for each

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selective occasion such as birthday or anniversary and the greeting can be non-specific novelty types of greetings.

As for dep. claim 6, the use of other well known finger ring for romantic or love sentiment such as diamond ring would have been obvious as mere selecting well known finger ring type.

As for dep. claims 7-9, the selection of the type and color of the heart shape, location of the engraving, etc, are considered as optimizing operating conditions or result effective variables to enhance or personalizing of the appearance of the ring and the optimizing of result effective variables is considered as routine experimentation to determine optimum or economically feasible reaction conditions and would have been obvious to the skilled artisan.

As for dep. claims 21-22, they are rejected for the same reasons set forth in claims 25-26. as optimizing operating conditions or result effective variables and the optimizing of result effective variables is considered as routine experimentation to determine optimum or economically feasible reaction conditions and would have been obvious to the skilled artisan.

**Apparatus claims 10, 11-16, 23-24** are rejected for the same reasons set forth in method claims 1, 3-8, 21-22, respectively since they both contain similar limitations.

**5. Claims 1-9, 21-22, 10-16, 23-24 are rejected (2<sup>nd</sup> time) under 35 U.S.C. 103(a) as being unpatentable over LOVE in view of ARTICLE 4/81 and MEJIAS (US Patent 5,069,045) alone or in view of STEFANY (US 2002/0178626) or HELN et al (US Patent 4,643,301).**

The teaching of LOVE / ARTICLE 4/81 and other obvious teachings of STEFANY and HELN et al are cited in claim 17 above. As for the promotion of the purchased item, this is inherently included in the general teaching of LOVE and further in view of the teaching on col. 1, lines 10-20, which teaches the proposal of articles of merchandise be mounted on and offered to the public and wherein the folded card and gift be associated with a container and sold as a packaged gift article. As for claim 1, LOVE fails to teach (1) providing a 1<sup>st</sup> insignia on an inner diameter of the a shank of the ring, (2) providing a 2<sup>nd</sup> insignia on a portion of the ring that is visible when the ring is positioned on a finger (or difference between claim 17 and claim 1). MEJIAS is cited to teach the enhancing the appearance of a ring or increasing the personalizing of a ring by engraving first ornamental markings or insignia or writings "LOVE" on a surface part of the ring (col. 1, lines 45-50) and engraving a second insignia (heart shape) (col. 2, lines 25-30) on a portion of the ring that is visible when the ring is positioned on a finger (see Fig. 5). It would have been obvious to modify the displaying a ring of LOVE/ARTICLE 4/81 by carrying out steps (1) and (2) as taught by MEJIAS to enhance the personalizing or appearance of the ring. Note that LOVE teaches the displaying of personal adornment such as earrings or the like which would inherently include finger ring or would have been obvious to apply to finger ring (see col. 1, lines 5-10).

The engraving of the 1<sup>st</sup> insignia on other part of the ring, inner diameter of the shank, or the selection of other well known or similar type of finger ring, etc., are considered as routine experimentations for personalizing or enhancing the appearance of a ring and would have been obvious. This is considered as optimizing operating

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conditions or result effective variables and the optimizing of result effective variables is considered as routine experimentation to determine optimum or economically feasible reaction conditions and would have been obvious to the skilled artisan. In re Aller, 105 USPQ 233.

As for dep. claim 2, this is shown on Fig. 5, 6 of MEJIAS. As for dep. claims 3, 4, the inclusion of other picture or caption in the display to increase the amount of love theme would have been obvious in view of the teaching of using messages, indicia, image, indicia, on a card or folder or frame, etc. to associate with the article theme. Note that on col. 1, lines 15-20, LOVE mentions the use of a picture as part of the display. As for dep. claim 5, the selection of a love quote would have been obvious in view of the teaching of "LOVE" in MEJIAS or LOVE col. 2, lines 5-12, which teaches the selection of a selective message for each selective occasion such as birthday or anniversary and the greeting can be non-specific novelty types of greetings. As for dep. claim 6, MEJIAS discloses the use of precious stone relating to "love" which normally refers to diamond or would have been in view of the popular use of diamond for love. As for dep. claims 7-9, the selection of the type and color of the heart shape, location of the engraving, etc, are considered as optimizing operating conditions or result effective variables to enhance or personalizing of the appearance of the ring and the optimizing of result effective variables is considered as routine experimentation to determine optimum or economically feasible reaction conditions and would have been obvious to the skilled artisan. As for dep. claims 21-22, they are rejected for the same reasons set forth in claims 25-26. as optimizing operating conditions or result effective variables and

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the optimizing of result effective variables is considered as routine experimentation to determine optimum or economically feasible reaction conditions and would have been obvious to the skilled artisan.

Apparatus claims 10, 11-16, 23-24 are rejected for the same reasons set forth in method claims 1, 3-8, 21-22, respectively since they both contain similar limitations.

### ***Conclusion***

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a):

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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7. Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, should be directed to the group clerical personnel and not to the examiner. As the official records and applications are located in the clerical section of the examining Tech Center, the clerical personnel can readily provide status information without contacting the examiner. See MPEP 203.08. The Tech Center clerical receptionist-number is (703) 308-1113

Or <http://pari-direct@uspto.gov>.

In receiving an Office Action, it becomes apparent that certain documents are missing, e. g. copies of references, Forms PTO 1449, PTO-892, etc., requests for copies should be directed to Tech Center 3600 Customer Service at (703) 306-5771, or e-mail [CustomerService3600@uspto.gov](mailto:CustomerService3600@uspto.gov) .

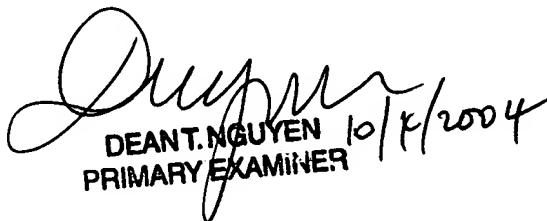
Any inquiry concerning the merits of the examination of the application should be directed to Dean Tan Nguyen at telephone number (703) 308-2053. My work schedule is normally Monday through Friday from 7:00 am through 4:30 pm.

Should I be unavailable during my normal working hours, my supervisor John Weiss may be reached at (703) 308-2702. The FAX phone numbers for formal communications concerning this application are (703) 305-7687. Informal communications may be made, following a telephone call to the examiner, by an informal FAX number to be given.

Other possibly helpful telephone numbers are:

Allowed Files & Publication	(703) 305-8322
Assignment Branch	(703) 308-9287
Certificates of Correction	(703) 305-8309
Drawing Corrections/Draftsman	(703) 305-8404/ 8335
Fee Questions	(703) 305-5125
Intellectual Property Questions	(703) 305-8217
Petitions/Special Programs	(703) 305-9282
Terminal Disclaimers	(703) 305-8408
Information Help Line	1-800-786-9199

dtn  
October 4, 2004

  
DEANT. NGUYEN  
PRIMARY EXAMINER 10/11/2004